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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/619,117 07/19/00 ATKINSON

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EXAMINER

SALIMI,A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED:

10/03/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
09/619,117

Applicant(s)

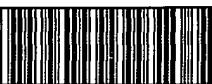
Atkinson et al

Examiner

ALI R. SALIMI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Jul 26, 2001.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 7, and 8 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2, 3, 5, and 6 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment B, paper No.7, filed 7/26/01. Claim 1 has been canceled. Claims 4-8 have been added. Claims 2-8 are pending in the application.

### ***Election/Restriction***

Newly submitted claims 4, 7-8 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 4 is directed to a product and the product of claim 4 is distinct over the method of claims 2-3, since the reagent of claim 4 can be utilized in induction of immune response. In addition, the product of claim 7 is distinct because the said product can be utilized in a different method such as a detection assay. The method as directed to claims 2-3 is different than the method claim directed to claim 8, since the method of claims 2-3 is for determining infection as oppose to method of claim 8 which is directed to screening adenovirus agents that are associated with obesity. Claims 4, 7-8 are patentably distinct products and method which comprise of divergent search and are classified in distinct class and subclass. The search for all claims would be burdensome.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 4, 7-8 are withdrawn from consideration as being directed to a non-

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elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Hence only claims 2, 3, 5, and 6 have been considered. Applicants are requested to cancel the claims in future correspondence.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Please note any grounds of rejection that has not been repeated is removed.

***Claim Rejections - 35 USC § 112***

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, for reasons of record advanced in the previous Office Action mailed 1/23/01. Applicant argues that in view of the amendment the claims are no longer deficient. Applicant's argument as part of amendment B, Paper NO. 7, filed 7/26/01 has been considered fully, but they are not persuasive. As it was clearly stated previously the claim is rather deficient for not reciting the conditions to practice the method. The claims have been examined in light of the specification and since the specification does not set forth the conditions and how the determination is made the claims are considered indefinite. What are the intended immunoanalytical or nucleic acid probe hybridization acid utilized in method(s)? What are the conditions of hybridization, is low stringency sufficient? How is the detection made? This affects claim 3.

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***Terminal Disclaimer***

The terminal disclaimer filed on 7/26/01 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patent no. 6,127,113 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 102***

Claims 2-3 are rejected under 35 U.S.C. 102(a) for reasons of record advanced in the previous Office Action mailed 1/23/01. Applicants have filed a declaration to overcome the rejection. The declaration filed on 7/26/01 under 37 CFR 1.131 has been considered but is ineffective to overcome the Antiviral Agents Bulletin 4/1/97 reference. The declaration has been singed by only one inventor. The declaration if signed by all inventors would be effective to overcome the reference cited under 102 (a). The rejection is maintained.

New grounds of rejection:

***Claim Rejections - 35 USC § 112***

Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: what are the nucleic acids utilized? What are the conditions of hybridization, is low stringency sufficient? What are the conditions sufficient to detect? How is the detection made? What type or types of tissues are intended?

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: what are the intended immunoanalytical probe? What are the conditions? How is the detection made? What type or types of tissues are intended?

No claims are allowed.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-3014, or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Ali R. Salimi

10/2/2001

*ARS*  
ALI R. SALIMI  
PRIMA EXAMINER